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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/708,036	02/04/2004	Ashok V. Joshi	CER-011125CO01	2035
22876	7590	06/02/2006	EXAMINER	
FACTOR & LAKE, LTD			GHALI, ISIS A D	
1327 W. WASHINGTON BLVD.				
SUITE 5G/H			ART UNIT	PAPER NUMBER
CHICAGO, IL 60607			1615	

DATE MAILED: 06/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/708,036	<b>Applicant(s)</b> JOSHI, ASHOK V.
	<b>Examiner</b> Isis Ghali	<b>Art Unit</b> 1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on \_\_\_\_.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-10 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-10 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)  The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s)

4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_.  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other:

## DETAILED ACTION

Claims 1-10 are pending and included in the prosecution.

### ***Specification***

1. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.
  
2. The use of the trademark "Nasicon" and "Nafion" has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 2 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claim 2 contains the trademark/trade names “Nasicon” and “Nafion”. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe reactive material and, accordingly, the identification/description is indefinite.

6. Regarding claim 5, the expressions “perovskites” and “+ $\delta$ ” does not set forth the metes and bounds of the claim. Recourse to the specification does not define the expressions “perovskites” and “+ $\delta$ ”.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-4, 6-10 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,985,388 ('308).

US '308 disclosed material for coating medical devices comprising metal oxides such as silver oxide and zinc oxide (abstract; col.4, lines 20-23; col.7, lines 11-21). The material can be used in medical devices such as wound dressing or prepared in ointment, solution or paint, i.e. reads on support and substrate (col.7, lines 35-42; col.8, lines 17-20). The silver oxide deposited with atom molecules of a different material. The different material includes metals such as Ti, Zn, Si, or oxides or halides thereof (col.7, lines 11-21) and this reads on the metal ion exchanged membrane recited in claim 2. The reference disclosed method for incorporating the material into the substrate comprising mixing the powdered metal with the adhesive tape (col.17, lines 44-46).

9. Claims 1-4, 6-8 are rejected under 35 U.S.C. 102(e) as being anticipated by US 6,333,093 ('093).

US '093 disclosed wound dressing where the skin contacting surface comprises substrate associated with metal selected from the group comprising silver (abstract; col.3, lines 1-7; col.5, line 40). The skin-contacting layer comprises matrix that

incorporates the silver oxide deposited with atom molecules of a different material. The different material includes metals such as Ti, Zn, Si, or oxides or halides thereof (col.3, lines 8-13); and this reads on the metal ion exchanged membrane recited in claim 2. The reference disclosed conventional method for incorporating the material into the substrate comprising mixing the powdered metal and the substrate (col.9, lines 27-35).

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over any of US '308 or US '093.

The teachings of US '308 and US '093 are discussed above, however, US '308 does not teach the materials recited in claim 5.

The materials recited in claim 5 are also metal oxides, and the cited prior art recognize the incorporation of metal oxide sin medical devices to obtain antimicrobial effect. The specific oxides recited in claim 5, do not impart patentability to the claims absent evidence to the contrary.

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide medical article comprising metal oxides as disclosed by any of US '308 or US '093, and select the metal oxides according to availability and compatibility to the site of application, with reasonable expectation of having medical device comprising the antimicrobial metal oxides that meet the specific needs.

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 6,267,782 disclosed medical articles with adhered antimicrobial elemental metals.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isis Ghali whose telephone number is (571) 272-0595. The examiner can normally be reached on Monday-Thursday, 7:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (571) 272-8373. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Isis Ghali  
Examiner  
Art Unit 1615

IG

*Isis Ghali*

ISIS GHALI  
PATENT EXAMINER